

R. Kent  
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PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q45980

Hisashi YAMAGISHI, et al.

Appln. No.: 08/898,853

Group Art Unit: 3711

Confirmation No.: 6473

Examiner: Raeann Gordon

Filed: July 25, 1997

For: MULTI-PIECE SOLID GOLF BALL

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**REPLY BRIEF PURSUANT TO 37 C.F.R. §1.193(b)**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellant respectfully submits this Reply Brief in response to the Examiner's Answer (Paper No. 49) mailed January 23, 2003.

Entry of this Reply Brief is respectfully requested.

**I. Grouping of Claims**

The Examiner contends that the rejection of claims 13-19 stand or fall together because Appellant's Brief on Appeal (herein "Brief") does not include a statement that the claims do not stand or fall together and reasons in support thereof. Although Appellant disagrees with the Examiner's statement about the content of Appellant's Brief, Appellant agrees that claims 13-19 stand or fall together in light of the Examiner's withdrawal of specific rejections of dependent claims 15, 16 and 18.

Appellant clearly sets forth in Section 7 “Grouping of Claims” on page 5 of the Brief that claims 13, 14, 17 and 19 stand or fall together, and claims 15, 16 and 18 do not. The reason for the specific grouping of claims was because the Examiner finally rejected claims 13, 15, 16 and 18 for separate and distinct reasons. Appellant provided specific and independent arguments consistent with this grouping of claims to address each of those separate and distinct reasons directed to claims 15, 16 and 18. (*See*, Brief at pp. 16-24.)

The Examiner has now withdrawn all prior rejections specifically drawn to claims 15, 16 and 18, except for the rejection of independent claim 13. That is, in the final Office Action (dated March 8, 2002), the Examiner finally rejected claims 13-19. Specifically, as set forth on page 2 of the final Office Action and as reprinted on page 5 of the Brief, the Examiner rejected and provided specific reasons for the rejections of claim 13 as well as claim 15 (thickness), claim 16 (specific gravity), and claim 18 (materials). Based on the Examiner’s Answer, the Examiner has withdrawn the specific rejections of claims 15, 16 and 18, and maintains the §112 rejection only with respect to claim 13. No mention is made of claims 15, 16 or 18 (other than their dependency on claim 13).

In view of the above, it is respectfully submitted that the specific reasons for rejecting dependent claims 15, 16 and 18 has been withdrawn and the sole remaining issue pertains to that of independent claim 13. Based on the fact that the Examiner has withdrawn all of the specific reasons for rejecting dependent claims 15, 16 and 18, Appellant agrees that the grouping of claims is that claims 13 - 19 stand or fall together.

## II. “Cover” Does Not Require Two Layers

In the Examiner’s Answer, the Examiner has abandoned all prior reasons for the rejection of claims 13-19 under §112 (first paragraph) and now offers a new argument concerning the definition of the word “cover.” This position is new, never articulated by the Examiner during the prosecution of the claims on appeal, and is wrong. Neither the specification including its written description and drawings nor the prosecution history dictates that “cover” mean two and only two layers.

The Examiner argues that the word cover necessarily means two layers and therefore claim 13 is limited to a five piece golf ball. This contention is inconsistent with the specification and Figure 2 of the present application, and inconsistent with the abundant prosecution history defining the scope of claim 13. Claim 13 merely recites a cover for coating the core. The specification provides for a golf ball having in general terms a core and a cover. (*See*, page 2, lines 14-15, page 5, lines 7-11.) Moreover, Fig. 2 shows the cross-sectional view of a four piece golf ball 10 having a cover denoted by reference numeral 14. (*See, also*, page 5, lines 15-20.)

Further, the cover as recited in the claim may refer in general to the “outer cover layer” 16 illustrated in Fig. 2 and described throughout the specification. There is no requirement that the cover as recited necessarily be and consist of two separate and distinct layers. In fact, when Appellant desired to recite a cover consisting of two layers the claims expressly required this feature by stating that the cover consisted of two layers or consisted of an inner cover layer and outer cover layer. (*See, for example*, claims 1-12 of the present application prior to their cancellation.) The word “cover” is generic and not limited to a specific number of layers.

The Examiner's position is also contrary to well-established Federal Circuit precedent prohibiting the reading of limitations from the specification into the claims. *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998) ("This court has repeatedly and clearly held that it will not read unstated limitations into claim language.") The Examiner's interpretation of cover is inconsistent with the plain and ordinary meaning of the word. The word "cover" does not require that it be two layers or limited to any other number of layers. In the context of claim 13 and as used in the present application, it is clear that the word cover is used generically to describe the outer covering of the golf ball. The present application does not ascribe a different meaning and certainly does not require cover as being a two layer cover.

### **III. Appellant's Position Is Consistent With Prior PTO Positions**

The Examiner again resorts to arguing that Appellant's position is at odds with the position by the Appellant's in Paper No. 6, filed October 28, 1998. This issue was sufficiently addressed in the Brief (pp. 12-14) and need not be further addressed here.

Further, the Examiner's new reliance on *Gentry Gallery Inc.* is inapposite. That case dealt with the issue of infringement under the doctrine of equivalents and not to one of claim construction and subject matter support under 35 U.S.C. §112. *Gentry Gallery* does not address comments a patentee made concerning one set of claims and how they apply to another set of claims. Clearly, *Gentry Gallery* does not stand for the proposition that a golf ball manufacturer can avoid the claims of the present application by the use of semantics by renaming the intermediate layers to be one of a core rather than a cover, or *vice versa*.

#### **IV. Examiner's Answer Fails To Address Appellant's Position**

What is critical here and never addressed by the Examiner's Answer is whether the specification of the present application teaches a golf ball having four layers with characteristics (e.g., hardness and thickness and material composition) as defined in claim 13 without regard to semantics or nomenclature used to describe the various layers of a golf ball. Appellant set forth in its Brief details on how the specification provides sufficient support for the rejected claims. Appellant also set forth how the rejected claims correspond to the Ohsumi '816 patent (with which Appellant seeks to provoke an interference). The Examiner does not dispute any of this.

Moreover, the Examiner never addresses and hence does not dispute the prior decision by the Board of Patent Appeals and Interferences where it addressed the very issue here in favor of Appellant. (*See*, Brief, p. 11 and Exhibit A.) The Examiner fails to follow the precedent set by this prior decision.

Even further, the Examiner never attempts to explain the prior positions taken by the PTO (Brief, pp. 12-14), the objective evidence submitted through the declaration of Mr. Larry Cadorniga (*Id.* at 15, Ex. B), and the objective evidence listing various other patents describing an intermediate layer as a core or a cover (*Id.* at 16, Ex C).

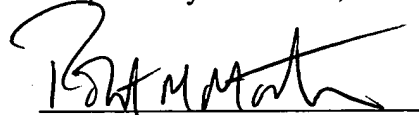
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**V. Conclusion**

For all of the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellant respectfully submits that claims 13-19 of the present application find adequate support in the disclosure of the present application and accordingly request that the rejection based on 35 U.S.C. §112, first paragraph, be reversed. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



Robert M. Masters  
Registration No. 35,603

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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Date: March 20, 2003